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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/739,802	12/20/2000	Kazuo Takaoki	2185-0495P	4025
2292	7590	01/21/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			LISH, PETER J	
			ART UNIT	PAPER NUMBER
			1754	

DATE MAILED: 01/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.	Applicant(s)	
09/739,802	TAKAOKI ET AL.	
Examiner	Art Unit	
Peter J Lish	1754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8,9,12,13 and 16-31 is/are pending in the application.
- 4a) Of the above claim(s) 24-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8,9,12,13,16,17,22 and 23 is/are rejected.
- 7) ☒ Claim(s) 18-21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Response to Amendment***

The Declaration under 37 CFR 1.132 filed 10/16/03 is insufficient to overcome the rejection of claims 8-9 and 12-13 based upon EP 0,683,184 as set forth in the last Office action because: the declaration only observes the properties of two of the compounds amongst multiple compounds taught by the reference which meet the claims. The argument that many of the compounds in EP '184 are not disclosed in specific examples does not negate the teaching of the reference with respect to their use.

Applicant's arguments with respect to claims 16-23 have been fully considered and are persuasive. The rejection of the claims as obvious over EP '184 in view of Manassen et al. has been withdrawn.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 102***

Claims 8-9, 12-13, 16-17, and 22-23 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0,683,184.

EP '184 teaches a polymerization catalyst containing a transition metal compound from groups 3 to 10 of the periodic table or a metal of the lanthanide series (see page 18, lines 10-13). Formulas I and IV in EP '184 teach substituted unsaturated cyclic hydrocarbon groups that bond with the transition metal such as cyclopentadienyl groups, which may be substituted with a heteroatom such as phosphorus or nitrogen. Also connected with the transition metal can be  $\alpha$ -

bond ligands such as a halogen or hydrocarbon group. Formula V on page 20 shows substituted or unsubstituted cyclopentadienyl groups may form a conjugated structure around the metal. Metallocenes are given as examples on page 26, lines 42-47. This compound is used with an additional catalyst component.

The additional catalyst component is disclosed on page 25. They can be phthalocyanine compounds which coordinate a metal from the groups 3-11 and 13-15. These compounds also contain an M5 or M6 element, which is selected from groups 5-15 and is preferably one of B, Al, Si, P, As, and Sb (see column 5, line 42). The claim limitation of having no group 13 metal is met by at least the elements Si, P, As, and Sb. The structures claimed in claims 12 and 13 are the definition of the phthalocyanine structure, provided R1 and R2 are hydrogen. Further disclosed is aluminoxane as another possible catalyst component (see page 25, line 2).

Regarding claims 16-17, the claims do not provide a positive limitation because the claims to which they depend do not require an "electron withdrawing group". No difference is seen between the EP '184 and the instantly claimed invention.

#### ***Allowable Subject Matter***

Claims 18-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J Lish whose telephone number is 571-272-1354. The examiner can normally be reached on 9:00-6:00 Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

PL



STUART L. HENDRICKSON  
PRIMARY EXAMINER